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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,964	01/16/2007	Florence Henry	C 2925 PCT/US	8591

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FOX ROTHSCHILD LLP
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PHILADELPHIA, PA 19103

EXAMINER

TATE, CHRISTOPHER ROBIN

ART UNIT	PAPER NUMBER
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1655

NOTIFICATION DATE	DELIVERY MODE
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11/18/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocket@foxrothschild.com

Office Action Summary	Application No. 10/597,964	Applicant(s) HENRY ET AL.	
	Examiner Christopher R. Tate	Art Unit 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 13-22 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 13-22 and 25-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08 September 2009 has been entered.

Claims 11, 13-22, and 25-29 are presented for examination on the merits.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 13, 14, 20-22, and 27-29 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Withel (1994 - reference cited by Applicants in the IDS submitted 2/20/2007).

Withel beneficially teaches preparing an extract composition from the leaves of *Castanea sativa* via pouring boiling water over finely cut leaves, letting it stand for a short time, passing the water extract solution through a strainer, adding cold water thereto (please note that water reads upon at least one instantly claimed cosmetic and/or dermopharmaceutical auxiliary and/or additive including "a biogenic active agent" since the term "biogenic" is defined in the art as "essential for maintaining the fundamental life processes; 'sleep and food and water are among

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the biogenic needs of the organism' " - i.e., from the website www.wordreference.com/definition/biogenic), which is then passed through another strainer (to remove the extract solvent from the leaf material). In addition, this reference teaches that such *Castanea sativa* leaf extract preparations have been incorporated into various prior art pharmaceutical compositions which would also intrinsically comprise such auxiliaries and/or additives therein (see page 133, third column under the headings *Making the tea* and *Phytomedicines*), or it would have at least been obvious for one of ordinary skill in the pharmaceutical art to do so to (especially given the numerous broad auxiliaries/additives which can be added thereto - as instantly claimed).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to prepare a therapeutic composition comprising an aqueous extract of *Castanea sativa* leaves as the active ingredient therein, based upon the beneficial teachings provided by the cited reference. The adjustment of particular conventional working conditions (e.g., determining an appropriate concentration of such a leaf extract and/or adding commonly employed auxiliaries/additives - many of which would also read upon cosmetic auxiliaries/additives - thereto) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

Thus, the invention as a whole is *prima facie* obvious over the reference, especially in the absence of evidence to the contrary.

Applicants' arguments concerning the above USC 103 rejection have been carefully considered but are not deemed to be persuasive of error in the rejection. Applicants argue that any auxiliaries/additives that may be incorporated into the *Castanea sativa* leaf extract

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phytomedicines (pharmaceutical compositions) designed to be taken internally, as taught by Withcl, would not be the same auxiliaries/additives added to cosmetic/dermopharmaceutical designed for topical administration as instantly claimed. However, firstly (as discussed above Withcl also teaches preparing an extract composition from the leaves of *Castanea sativa* via pouring boiling water over finely cut leaves, letting it stand for a short time, passing the water extract solution through a strainer, adding cold water thereto (please note that water reads upon at least one instantly claimed cosmetic and/or dermopharmaceutical auxiliary and/or additive including "a biogenic active agent), which is then passed through another strainer (to remove the extract solvent from the leaf material). Secondly, based upon the numerous broad auxiliaries/additives within the Markush group instantly claimed (including, e.g., "biogenic active agents", "superfating agents", "hydrotropes" - any of which would at least have been obvious to add to such internal compositions), the various prior art internal phytomedicines (pharmaceutical compositions) disclosed by Withcl reasonably read upon the instantly claimed invention. Please also note that nothing would preclude these various internal prior art *Castanea sativa* leaf extract-containing phytomedicines from being topically applied to the skin.

Claims 11, 13-22, and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiej (MacDonald Encyclopedia of Medicinal Plants, 1984) in view of Grand (US 3,849,548) and the admitted state of the art, with evidence provided by Chevallier (Encyclopedia of Herbal Medicine, 2000)*.

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Chiej teaches that a hair shampoo comprising an extract (e.g., in the form of an infusion or other fluid extract) of *Castanea sativa* leaves is well known in the art to impart a golden gleam to the hair, and that *Castanea sativa* leaves have been used in the prior art as a substitute for witch hazel (see # 72 - herbal description of *Castanea sativa*). As evidenced by Chevallier, infusions are prepared via placing the plant/herbal material in a strainer, then placing the strainer in hot/boiling water for 5-10 minutes, removing the strainer (with the plant/herbal material inside) to produce the extract infusion (see page 291 of Chevallier). Further, as evidenced by Chevallier, witch hazel is notoriously well known in the prior art to be used cosmetically to topically treat such ailments as skin abrasions, facial veins, varicose veins, and hemorrhoids, including in the form of a lotion or ointment (see page 104 of Chevallier).. Thus, the infusion of *Castanea sativa* leaves (within such a hair shampoo and/or cosmetic) as reasonably taught/suggested by Chiej reads upon the instantly claimed *Castanea sativa* leaf extract and preparatory method thereof. Chiej does not appear to expressly teach the inclusion of one or more of the auxiliaries/additives instantly claimed within such a hair shampoo or cosmetic product comprising *Castanea sativa* leaf extract therein.

Grand teaches cosmetic hair/skin care products including in the form of a cleansing hair (shampoo) and/or skin composition (containing surfactants therein) which may further comprise other adjuvants/substances therein such as plant extracts including so to enhance the cosmetic properties thereof (see entire document including col 4, lines 56-61 and col 9, lines 34-41). Further, as readily admitted by Applicants, the instantly claimed auxiliaries/additives are well known in the art to be common for cosmetic purposes.

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It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to provide a hair shampoo comprising an effective amount of a *Castanea sativa* leaf extract (such as in the form of an infusion) as an active cosmetic ingredient therein with respect to functioning to impart a golden gleam to the hair (as beneficially taught by Chief) and/or to provide a cosmetic skin care composition comprising an effective amount of a *Castanea sativa* leaf extract so as to function effectively as a substitute for witch hazel when topically applied to an area of skin in need thereof - including within a conventional hair (shampoo) and/or skin care product such as one comprising one or more surfactants therein and/or other admittedly well known conventional cosmetic auxiliaries/additives therein, including a hair (shampoo) and/or skin care product in which plant extracts can be incorporated therein (for their known cosmetic purpose), such as beneficially taught by Grand. The adjustment of particular conventional working conditions (e.g., determining an appropriate amount of an infused *Castanea sativa* leaf extract to incorporate therein and/or using a conventional extraction solvent to prepare such a *Castanea sativa* leaf extract) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

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* Please note that the Chevallier reference is not being cited as art within the USC 103 rejection immediately above, but instead is being cited to show an inherent feature with respect to preparing a plant infusion (e.g., from *Castanea sativa* leaves) such as reasonably taught/suggested by the Chiej reference, as well as to show the well known prior art cosmetic uses of witch hazel (as discussed within the USC 103 rejection above).

Conclusion

No claim is allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Tate whose telephone number is (571) 272-0970. The examiner can normally be reached on Mon-Thur, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher R. Tate/
Primary Examiner, Art Unit 1655